

THIS DISPOSITION IS NOT
CITABLE AS PRECEDENT
OF THE TTAB

Mailed:
9/9/03

Paper No. 28
RFC

UNITED STATES PATENT AND TRADEMARK OFFICE

Trademark Trial and Appeal Board

In re Rosen Product Development

Serial No. 75/152,131

David P. Cooper of Kolish, Hartwell, Dickinson, McCormack & Heuser for Rosen Product Development.

Carolyn Pendelton Cataldo, Trademark Examining Attorney,
Law Office 103 (Michael Hamilton, Managing Attorney).

Before Cissel, Seeherman and Drost, Administrative
Trademark Judges.

Opinion by Cissel, Administrative Trademark Judge:

On August 19, 1998, applicant filed the above-referenced application to register the mark "ULTRASLIM-LINE" on the Principal Register for "monitor mounting devices and visors," in Class 9. The application was based on applicant's claim that it had used the mark in commerce in connection with these goods since February 20, 1996.

Following a number of exchanges between the Examining Attorney and applicant, the drawing was amended to show the

mark as "ULTRA SLIM-LINE," and the identification-of-goods clause was amended to identify the goods as "computer accessories, namely, hardware systems for mounting with monitors," in Class 9.¹

This application is now before the Board on appeal. Two issues are presented for our resolution: (1) the Examining Attorney's final requirement for a disclaimer, under Section 6(a) of the Lanham Act, of the term "SLIM-LINE," which the Examining Attorney has held to be merely descriptive of the goods identified in this application, as amended; and (2) the final requirement for an amendment to the identification-of-goods clause to specify the component parts of the "systems" referred to in the amended identification of goods.

Section 6(a) of the Lanham Act provides that an applicant may be required to disclaim an unregistrable component of a mark which is otherwise registerable. The Examining Attorney contends that the term in question, "SLIM-LINE," is unregistrable under Section 2(e)(1) of the Lanham Act because it is merely descriptive of the products

¹ On April 24, 2002, the application was remanded to the Examining Attorney for clarification of the wording applicant intended to adopt by an earlier amendment. After applicant specifically adopted the language shown above, the Examining Attorney continued and made final the requirement for amendment to the identification-of-goods clause.

with which applicant uses the mark it seeks to register.

The test for determining whether a term is merely descriptive within the meaning of the Act is well settled. A term is unregistrable under Section 2(e)(1) if it describes an ingredient, quality, characteristic, function, feature, purpose or use of the relevant goods. In re Gyulay, 820 F.2d 1216, 3 USPQ2d 1009 (Fed. Cir. 1987); In re Bed & Breakfast Registry, 791 F.2d 157, 229 USPQ 818 (Fed. Cir. 1986); In re MetPath Inc., 223 USPQ 88 (TTAB 1984); In re Bright-Crest, Ltd., 204 USPQ 591 (TTAB 1979).

The evidence of record clearly establishes that the term "SLIM-LINE" is commonly used to describe sleek, slender or streamlined products or components of products in many different industries, including the computer industry. Submitted with the Office Actions of March 22, 1999 and July 24, 2001 were a number of excerpts from published articles retrieved from the Nexis database. The term in question is used in these excerpts in a descriptive context in connection with computer-related goods, including monitors, and related high-technology products such as audio components and other electronic devices. Typical examples include the following: "Other new Office in the Sky products include an 18-inch slim-line LCD monitor..."; "12.1-inch, custom-designed, slim-line video

monitors..."; and "The CML 151XW is a slim-line lightweight monitor that offers a high-resolution liquid crystal display..." Other excerpts show use of "slim-line" in connection with other electronic or computer-related products in apparent reference to the same feature or characteristic, that is, their narrow configuration.

This evidence clearly demonstrates that "SLIM-LINE" is used to describe a significant, desirable characteristic of computer monitors. As such, the term would be unregistrable under Section 2(e)(1) of the Act in connection with computer monitors. When this term is used in connection with hardware for mounting slim-line monitors, the term is likewise unregistrable because it identifies a significant characteristic or feature of these products, namely, either that the mounting hardware is itself slim or narrow, or that the hardware is designed to accommodate slim-line computer monitors. In fact, the specimen submitted with the application shows both that the monitor applicant sells is less than an inch thick ("Our lightest and thinnest entertainment LCD."), and that the mounting hardware designed to attach it to the interior of aircraft is of a "compact design," which is only slightly thicker. "SLIM-LINE" is therefore merely descriptive of a significant characteristic or feature of the mounting

hardware as well as the monitors with which the hardware is used. In view of this fact, the requirement for a disclaimer of this unregistrable term is appropriate.

Applicant makes several unpersuasive arguments to the contrary. One is that the term is only suggestive of a characteristic of monitors and hardware for mounting with monitors because it takes a multi-step reasoning process to understand what the term means in connection with these products. Applicant has not, however, explained what this process is. As noted above, the evidence supports the conclusion that the ordinary meaning of the term immediately and forthwith conveys significant information about a feature or characteristic of the products with which it is used, namely that they are slim or narrowly configured.

Applicant argues that the Court's decision in the case of *In re Automatic Radio Mfg. Co.*, 404 F.2d 1391, 160 USPQ 233 (CCPA 1969) supports registrability of applicant's mark in the instant case without the required disclaimer, but we find that the decision in that case does not require reversal of the requirement for a disclaimer in the case at hand. In that case the Court reversed the refusal to register because the record did not contain evidence that the term in question was used descriptively in connection

with the specific goods identified in the application. In the instant case, however, as noted above, not only do we have evidence that "SLIM-LINE" is used to describe a feature or characteristic of a variety of different high-technology products, but the record shows that computer monitors themselves have been described as "slim-line," and that the hardware applicant sells for mounting slender monitors in aircraft likewise features this narrow configuration.

Applicant's argument that the disclaimer requirement is improper because the term "slim-line" has not been shown to be in use in connection with hardware for mounting monitors in vehicles is also not well taken. As noted above, even if the hardware were not itself "slim-line," the term would still be unregistrable for the hardware because a significant feature or characteristic of it is that it is used to mount "slim-line" monitors.

Additionally, applicant's argument that the application should be approved for publication without the required disclaimer because doubt exists as to whether "SLIM-LINE" is merely descriptive of the goods specified in the application, as amended, is also without merit. The evidence is clear that the requirement for a disclaimer is proper because the term is unregistrable under Section

2(e)(1) of the Act. We have no doubts regarding this conclusion.

The second issue on appeal is the propriety of the Examining Attorney's requirement for further amendment to the identification-of-goods clause to specify the component parts of the "systems" identified in the existing language in the application. Section 1 of the Act requires an applicant to state the goods in connection with which the mark is used. The Office has consistently held that this must be done with a degree of specificity and particularity which allows for proper examination of the application and provides the public with fair notice of the extent of the rights being claimed by the applicant.

In the instant case, the Examining Attorney has required applicant to specify what is intended to be included by the indefinite term "systems." She has suggested that applicant adopt the following language: "computer accessories, namely, hardware systems comprised of [IDENTIFY major component parts] for mounting with monitors." We agree with the Examining Attorney that the term "systems" is indefinite, and that the components of applicant's mounting hardware systems should be specified. Accordingly, the requirement for amendment to the identification-of-goods clause is affirmed.

Ser No. 75/152,131

DECISION: The requirement for applicant to amend the application to specify the components of its hardware systems is affirmed, as is the requirement to disclaim the merely descriptive term "SLIM-LINE."